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09/820,457	03/28/2001	Michael J. Borg	10006799-1	6674
22879 7590 08/26/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER				
NGUYEN, TAN D				
ART UNIT		PAPER NUMBER		
3689				
NOTIFICATION DATE		DELIVERY MODE		
08/26/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

09/820,457

**Applicant(s)**

BORG ET AL.

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status***

1. In view of the BPAI decision filed on 4/22/08, PROSECUTION IS HEREBY REOPENED. The rejection is set forth below.

### ***Claim Status***

Claims 1-19 are pending. They include 1-9 (method<sup>1</sup>), 10-15 (system) and 16-19 (method<sup>2</sup>). Claims 20-25 are canceled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**5. Claims 1-8 and 16-19 and are rejected under 35 U.S.C. 103(a) as obvious over HAYWARD et al in view of KLINEFELTER et al alone and/or further in view of Official Notice.**

claim 1 basically reads:

(a) retrieving data from component memory of (or integrated with) a replaceable component from a printing device;

b) storing the data in a database;

c) associating the data with a customer; and

(d) accessing the data in the database,

wherein the data is used to assist the customer with solving problems related to the printing device (diagnostic).

Note:

1) in step (d), the phrase "to assist the customer ... the printing device" is not a positively recited method step but, rather is mere intended use of the accessed data. (Footnote<sup>2</sup>, page 3 of Board decision on 4/22/08).

2) the phrase "integrated with" in step (a) is used in claim 16.

3) alphabetical letters are added to the beginning of each step for convenience.

Similarly, in a printing system with operation monitoring system, **HAYWARD et al** discloses the monitoring (communication) steps comprising:

(a) retrieving data (communicating/**interrogating**) from an integrated components including a replaceable component (cartridge, ink, ribbon) and others (sensor, processor, etc) from a printing device;

{see Fig. 8, elements (8) which includes a sensor (12) and replaceable component (8), (34), (38), (36), (50), col. 9, lines 10-20 "...*may regularly or intermittently interrogate the consumable component for information...*", lines 43-55, col. 7, lines 3-65, col. 8, lines 5-67}

b) storing the data in a database;

{see Fig. 8, server/database 40, element 8, 50, 36, 34 and 38, col. 9, lines 10-25,

c) associating the data with a customer; and

{see col. 9, lines 24-27, col. 7, lines 60-67, col. 8, lines 5-52}.

(d) accessing the data in the database,

wherein the accessed data is used for interrogation of the condition of the replaceable component (consumable component 11).

{see Fig. 8, server/database 40, element 8, 50, 36, 34 and 38, col. 9, lines 10-27, "...*may regularly or intermittently interrogate the consumable component 11 for information ... then process and communicate such information to the server 40...*", col. 7, lines 60-67, col. 8, lines 5-52}.

Note: in view of the general teaching of "accessing the manufacturer's server 40 for information or services", as cited on col. 6, lines 35-57 and col. 7, lines 60-67, it would have been obvious to include this "accessing the database/server" in col. 7, lines 20-57, in order to obtain/view information (interrogation the condition of replaceable component (consumable component 11) or perform services such as initiating an electronic ordering for a replacement of the consumable component ordering as indicated above. Therefore, HAYWARD et al fairly teaches the claimed invention except for step (a) wherein the data is retrieved from the memory component of the integrated components. In other word, the integrated components include a memory component besides the replaceable component and others wherein the data is retrieved from.

**KLINFELTER et al** is cited to teach the use of memory component (or tag or ID tag) integrated with a printer replaceable component such as toner cartridge, ink, ribbon, etc. to store information or data about the replaceable component (or related to the printing device such as the cartridge or ink ribbon or the printer) for **diagnostics** (solving problems) or for **reordering supplies** {see Figs. 7, ink cartridge or supply 144, memory component 168, tag 142, Fig. 9, RFID Tag memory, col. 4, lines 5-55, "...information from a printer programmed into the ID tag 15 which indicates the type of printer used last.", col. 5, line 50 to col. 6, line 16 "...record information or read information from memory 168....A part number stored in memory 168 can be used for diagnostics and for reordering additional supplies.".

Therefore, it would have been obvious to a skilled artisan to modify the integrated components in the system of HAYWARD et al to include a memory component for storing data about the replaceable component or the printer as taught by KLINEFELTER et al for diagnostic or reordering the correct supplies. Note that this matches the intended use of the accessed data in step (d) claim 1 above which is "to assist the customer with solving problems related to the printing device (diagnostic)".

Official Notice is taken that it's well known in the art to integrate memory component (or memory tag or ID tag) in a target component (or integrated with the target component) to monitor/manage (record/track/interrogate) the operation of the target component (or replaceable) for diagnostic or re-order the proper supplies. This concept is taught in HARDMAN et al {see abstract, Figs. 1A, 12, 15} or BECKER et al {see abstract, Figs. 23, col. 15-16}. Therefore, it would have been obvious to integrate memory component (or memory tag or ID tag) in the replaceable component of HAYWARD et al/KLINEFELTER et al to monitor/manage (record/track/interrogate) the operation of the replaceable consumable component (cartridge) for diagnostic or re-order the proper supplies.

**As for dep. claims 2-3** (part of 1), which deals with well known information/data parameters, i.e. type of information/data such as about the device and its usage, these are non-essential to the claimed invention and are fairly taught in HAYWARD et al / KLINEFELTER et al as shown in HAYWARD et al Figs. 3, 5-6, col. 2, lines 35-50, col. 4, lines 32-67, col. 8, lines 30-45, col. 9, lines 20-67. Note that the selection of the type of

information depends on the desired object/scope/monitoring parameter, etc. and is within the skilled of the artisan..

**As for dep. claims 4** (part of 1), which deals with well known information/data parameter, i.e. type of information/data such as previously stored in a database, this is non-essential to the claimed invention and are fairly taught in HAYWARD et al col. 6, lines 35-65, col. 8, lines 35-60, or KLINEFELTER et al col. 4, lines 45-52, Fig. 9.

**As for dep. claims 5-6** (part of 1), which deals with well known information/data parameter, i.e. features of the information/data previously stored in a database, these are non-essential to the claimed invention and are fairly taught in HAYWARD et al Figs. 6, 8, col. 2, lines 5-16, col. 8, lines 1-25. Note that in claims 5-6, the phrase "is derived from...components or registration card", is not a positively recited method step, but rather is mere intended use of the term "rules", thus having no patentable weight in a method claim. Moreover, the obtaining customer information from registration card is well known and mentioned in the background of the invention, page 1, middle paragraph. Moreover, these are non-functional language limitation, i.e. "is derived", and carry no patentable weight.

**As for dep. claim 7** (part of 1), which deals with well known device parameter, i.e. type of printer and component, these are non-essential to the claimed invention and are fairly taught in HAYWARD et al in col. 9, lines 35-42, col. 10, lines 13-18 or KLINEFELTER et al col. 1, lines 5-20. The use of any similar types of printer or cartridge would have been obvious as mere using any other similar types.



**As for dep. claim 8**, the phrase "to be followed...meets certain criteria", is not a positively recited method step, but rather is mere intended use of the term "rules", thus having no patentable weight in a method claim. Furthermore, the phrase "comprising associating rules" does not further limit step 1 and thus having no patentable weight. Moreover, "rules" or "logic" is taught on HAYWARD et al col. 2, lines 40-45. Moreover, this would have been obvious to a skilled artisan as mere applying other well known business parameters or variables since the selection of any well known business rules for compensation of irregular product or service would have been obvious, i.e. free replacement of product or service for malfunction within the 1<sup>st</sup> year of normally guaranteed performance. Note that no specific rules is cited, but just a rule so this appears to be non-essential since rules are inherently included in every business dealings.

As for dep. claim 9, the phrase "if a defect is found.... The customer database", is not a positively recited method step, but rather is mere intended use of the term "data" in claim 1, thus having no patentable weight in a method claim. Furthermore, this dep. claim does not has any patentable weight since it does not further limit the "retrieving data from a component<sup>1</sup>/ item<sup>1</sup> memory (tag memory)" of step (a) or steps (a)-(e)?

**As for Independent Method<sup>2</sup> claim 16**, which is similar to claim 1 with a preamble which is considered to be "capable of doing" as shown in step (d) of 1, the compiling reads over steps (a) - (c) of claim 1 and step (b) reads over step (d) of claim 1. It's rejected for the same reason set forth in claim 1 above.

Note: in step (b), the phrase "to view compiled data ... the printing device" is not a positively recited method step but, rather is mere intended use of the accessed data, and has no patentable weight. (Footnote<sup>4</sup>, page 4 of Board decision on 4/22/08).

Furthermore, the limitation of viewing the compiled data to resolve a problem the customer is having, this is taught in KLINEFELTER et al col. 6, lines 10-16 or HAYWARD et al Fig. 3 "'On-Line Help".

As for dep. claim 17 (part of 16), which deals with well known automatic customer ordering management parameters, i.e. storing customer information for a customer in the database and associating the customer information with the compiled data, this is taught in HAYWARD et al Figs. 5-6, col. 4, lines 47-67 or KLINEFELTER et al col. 6, lines 10-16.

As for dep. claims 18-19 (part of 16 above), which deals with well known automatic customer ordering management parameters, i.e. acquiring the customer information from a source and associating the customer information with general data, these are taught in HAYWARD et al Fig. 5, col. 4, lines 5-10, 47-67, col. 5, lines 1-10, col. 9, lines 20-55 or well known facts as indicated in the specification page 1, lines 15-21 or KLINEFELTER et al col. 6, lines 10-15.

6. Claim 9 is also rejected under 35 U.S.C. 103(a) as being unpatentable over HAYWARD et al /KLINEFELTER et al or further in view of Official Notice as applied to claims 1-9 above, and further in view of YOKOMORI et al.

**YOKOMORI et al** is cited to teach well known elements/functions for recycling of the process printing ink cartridge wherein the used process cartridges are collected and delivered to the collection center and then transported from the collection centers to a cartridge recycling plant (center) whereby the used cartridges are classified or grouped and then go through the processes of dis-assembling, selecting, cleaning, inspection and re-assembling {see cols. 35-36}. Therefore, it would have been obvious to test the used replaceable component for a defect, storing the data and associate the customer for inherently improving recycling product efficiency and customer problems as taught in cols. 1 and 36 of **YOKOMORI et al**.

**7. Claims 10-15 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over HAYWARD et al in view of KLINEFELTER et al alone or further in view of Official Notice, and further in view of YOKOMORI et al.**

**As for independent system claim 10, HAYWARD et al discloses:**

10. (original): A system, comprising:

a center "to receive a used printing device replaceable component from a printing device of a customer, the printing device replaceable component including component memory integrated therewith";

{see col. 3, lines 65-67, col. 9, lines 5-50}

a customer database that stores customer information for multiple customers, including printing devices and printing device replaceable components used by the customers;

{see Fig. 8, server/database 40, element 8, 50, 36, 34 and 38, col. 9, lines 24-27, col. 7, lines 60-67, col. 8, lines 5-52}.

a data transfer center wherein printing device data is retrieved the components and stored in the customer database; and

{Figs. 2, 8, col. 3, lines 39-67, col. 4, lines 30-45, col. 9, lines 1-50}

a center configured to receive calls from the customer and provide operator access to the customer database "so that the operator can view the printing device data".

{see Figs. 2, 8, col. 3, lines 39-67, col. 4, lines 30-45, col. 9, lines 1-50} .

Note that claim 10 is an apparatus claim. Note that that claim 6 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Cir. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation, i.e. "to receive..", "wherein printing device data is retrieved from...database", and "so that ...device data", etc. carries no patentable weight.

HAYWARD et al fairly teaches the claimed invention except for explicitly (1) calling the 1st center as "recycling center to receive a used printing device replaceable component", (2) calling the last center as "customer service center", and (3) the features in the component of the source of the retrieved data in the data transfer center, i.e. from a component memory of a replaceable component from a printing device.

However, in view of the teachings on Fig. 3, col. 4, lines 40-45, col. 5, lines 30-39, col. 9, lines 45-50, which deals with customer service, on-line help, order supplies, part supplier, etc., it would have been obvious to call the part supplier or manufacturer, or a consumable item vendor as customer service center. Therefore, HAYWARD et al fairly teaches the claimed invention except for explicitly (1) calling the 1st center as "recycling center to receive a used printing device replaceable component", and (2) the features in the component of the source of the retrieved data in the data transfer center, i.e. from a component memory of a replaceable component from a printing device.

The teachings of KLINEFELTER et al is cited above. Therefore, it would have been obvious to a skilled artisan to modify the integrated components in the system of HAYWARD et al to include a memory component for storing data about the replaceable component or the printer as taught by KLINEFELTER et al for diagnostic or reordering the correct supplies. Note that this matches the intended use of the accessed data in

step (d) claim 1 above which is "to assist the customer with solving problems related to the printing device (diagnostic)".

Official Notice is taken that it's well known in the art to integrate memory component (or memory tag or ID tag) in a target component (or integrated with the target component) to monitor/manage (record/track/interrogate) the operation of the target component (or replaceable) for diagnostic or re-order the proper supplies. This concept is taught in HARDMAN et al {see abstract, Figs. 1A, 12, 15} or BECKER et al {see abstract, Figs. 23, col. 15-16}. Therefore, it would have been obvious to integrate memory component (or memory tag or ID tag) in the replaceable component of HAYWARD et al/KLINEFELTER et al to monitor/manage (record/track/interrogate) the operation of the replaceable consumable component (cartridge) for diagnostic or re-order the proper supplies.

**YOKOMORI et al** is cited to teach well known elements/functions for recycling of the process printing ink cartridge wherein the used process cartridges are collected and delivered to the collection center and then transported from the collection centers to a cartridge recycling plant (center) whereby the used cartridges are classified or grouped and then go through the processes of dis-assembling, selecting, cleaning, inspection and re-assembling {see cols. 35-36}. Therefore, it would have been obvious to modify the name of the receiving center or plant in HAYWARD et al/KLINEFELTER et al alone or further in view of Official Notice, as cartridge recycling plant (center) whereby the used cartridges are collected and recycled as "recycling plant/center" as taught by

YOKOMORI et al for processing used printing cartridges, As shown on col. 35, lines 50-67.

As for dep. claims 11-13 (part of 10), which deal with the type of data, i.e. information about the printing device and its usage, these are taught in HAYWARD et al Figs. 3, 5-6, col. 2, lines 35-50, col. 4, lines 32-67, col. 8, lines 30-45, col. 9, lines 20-67. Note also that phrase "information that is stored...component installed" etc, are not a positively recited apparatus structures, but rather is mere intended use of the term "information", thus having no patentable weight in an apparatus claim.

As for dep. claim 14 (part of 10), that phrase "...where used printing device replaceable components are tested ...", is not a positively recited apparatus structures, but rather is mere intended use of the term "center", thus having no patentable weight in an apparatus claim. Also, the term "quality assurance" is mere intended use of the term "center", thus having no patentable weight in an apparatus claim. This is taught in YOKOMORI et al col. 36, lines 5-13, Moreover, it would have been obvious to any center quality assurance its job is to ensure quality of the product or service is up to the standard or specification.

As for dep. claim 15 (part of 10), which deal with the type of information/data, i.e. information about the features of the printing device and cartridge, these are non-essential to the scope of the claimed invention and are taught in HAYWARD et al col. 9, lines 35-42, col. 10, lines 13-18. The use of any similar types of printer or cartridge would have been obvious as mere using any other similar types.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Hardman et al, US 2002/0,075,145 – teaches the use of memory tag integrated in a replaceable component for remote management/monitoring through the use of a global network (Internet) the operation of the replaceable component and its system to maximize the replaceable component and its related system efficiency. See pars. [0003], [0234], Figs. 1A, 12 “Remote Server”, and 15 for diagnostic (interrogation) and reordering supplies purpose.

2) Becker et al, US 6,271,643 – similar teachings to HARDMAN et al above, with retrieving data from memory tags attached to the replaceable component (battery) for interrogation of the memory for relevant device history and then selectively determine a suitable operation criteria. See Fig. 23, col. 15-16. This reference is cited here for applicant's awareness of potential use in the future if needed to avoid duplicate rejection.

3) Johnson et al, US 6,067,525 - integrated computer sales force automation and customer profile and management.

4) Guheen et al, US 6,519,571 – dynamic customer profile management.

5) Allen, US 6,233, 408 – image forming device with token printing capabilities. .

6) Hayward, US 6,985,877 – supply ordering.



9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689

/Wynn W. Coggins/  
Director, TC 3600